



#AF/3624

Docket 80052F-P  
Customer No. 01333

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Richard L. Alfvén, et al

ELECTRONIC IMAGING  
CAPTURE AND BILLING  
DISTRIBUTION SYSTEM

Serial No. 09/607,140

Filed June 29, 2000

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

Group Art Unit: 3624

Examiner: Narayanswamy Subramanian

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*Deborah J. Walczak*  
Deborah J. Walczak

*September 18, 2003*  
Date

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Sir:

**APPEAL BRIEF TRANSMITTAL**

Enclosed herewith in triplicate is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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Enclosures



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**APPEAL BRIEF PURSUANT TO 37 C.F.R. 1.192**

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## **APPELLANT'S BRIEF ON APPEAL**

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-16 which was contained in the Office Action mailed December 18, 2002.

A timely Notice of Appeal was filed July 18, 2003.

### **Real Party In Interest**

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

### **Related Appeals And Interferences**

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

### **Status Of The Claims**

Claims 1-16 have been rejected and are appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

### **Status Of Amendments**

All of the amendments have been entered and the claims stand as indicated in Appendix I.

### **Summary Of The Invention**

The present invention is directed to a method and system for managing digital images captured by a customer using a combined portable telecommunication and digital image capture device 10. A telecommunication service provider provides a telecommunication service to the customer who also provides a periodic statement 40 with regard to services for the telecommunication services for a predetermined time period. The service provider maintains a database for receiving and storing digital images from the customer using the telecommunication device. The service provider then provides to the customer a visual representation 30 of the captured images that are taken

over a predetermined time period along with the periodic statement 40. The periodic statement may comprise a multi-sectional form having a first portion 80 wherein the form comprises a billing invoice for a telecommunication services and image service charges accumulated for the predetermined time period. The multi-sectional statement also includes a second portion 110 which contains a hard copy in the print of the images taken and a third portion 140 for the use in ordering photographic goods and/or services based on the images contained in the index print 30.

### **Issues For Review By The Board**

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1, 2 and 8-14 are unpatentable under 35 USC § 103(a) as being unpatentable over Reelee et al. in view of Kolling et al.
2. Whether claims 3 and 7 are unpatentable under 35 USC § 103(a) as being unpatentable over Reelee et al. in view of Kolling et al. and further in view of Enomoto et al.
3. Whether claims 4-6 are unpatentable under 35 USC § 103(a) over Reelee et al. in view of Kolling et al. and Enomoto et al. and further in view of Loeb et al.
4. Whether claims 15 and 16 are unpatentable under 35 USC § 103(a) over Kolling et al. in view of Loeb et al.

### **Grouping Of Claims**

- |            |                    |
|------------|--------------------|
| Group I:   | Claims 1, 2, 8-14. |
| Group II:  | Claims 3 and 7.    |
| Group III: | Claims 4-6.        |
| Group IV:  | Claims 15 and 16.  |

## **Arguments**

### ***The Rejection***

#### ***Group I - Claims 1, 2, 8-14***

- A. The Examiner in the Official Action dated April 22, 2003 rejected claims 1, 2, 8-14 for the reasons set forth in the Official Action dated December 18, 2002 whereby the Examiner stated that claims 1, 2 and 8-14 were unpatentable over Reelee et al. in view of Kolling et al. under 35 USC § 103(a) for the reasons set forth therein.

The present invention is directed to a combined cellular phone and digital camera which not only can be used to capture images but are also used for telecommunication transmissions. One problem that arises is that these types of devices are typically limited in the amount of image storage that many images can be maintained which results in the customer having a need to manage many images that can be captured. The use of digital cameras make it easy for people to capture hundreds of images wherein in the past with film type cameras, users would only capture a few. A problem with prior type digital cameras is that at certain points image are required to be downloaded which requires some type of active work on the customer's account. With the many images that can be captured, the managing of all of these images becomes much more difficult. Since it is easy to capture images, not all images are desired to be kept in use, so there must be an efficient way to sort these images out. The present invention is designed to solve many of the problems that exist in prior art. By combining the services of a telecommunication provider with that of a provider that stores images storage and fulfills orders, the problems of the prior art can be minimized. Independent claims 1 and 9 each include the limitation of a telecommunication service provider that provides a telecommunication service to a customer with respect to a combined portable telecommunication and digital image capture device. The service provider uses a database for receiving stored digital images that have been transmitted to the service provider and the telecommunication service provider provides the customer with a visual representation of the images captured during a predetermined time period along with a periodic statement for the telecommunication services.

The Reelee et al. reference is directed to a combined camera and telecommunication device. A telecommunication service (e.g. cellular telephone 28) is coupled to the camera 10. The Examiner states that Reelee et al. discloses a

telecommunication service to a customer and for receiving and storing the digital image from the customer using the combined telecommunication device to transmit the digital images to the service provider. In particular, the Examiner relies on column 5, lines 25-43 of Reelee et al.. However, applicants respectfully submits that Reelee et al. does not teach the sending of the images to a service provider. Quite the contrary, what is set forth at column 5, lines 25-43 is that the operator (i.e. the owner of the camera) can have images sent to a remote location. There is no indication or suggestion in the reference that the images would be sent to a image service provider for storage. Further, neither Reelee et al. or Kollings et al. disclosed the claimed feature of providing a "visual representation of said captured images" along with a periodic statement for telecommunication services. The Examiner cites Kolling et al. to provide this feature. However, Kolling et al. merely discloses the supplying of a logo or other graphic on a periodic statement, or the including of enclosures with the statement. A corporate logo or advertising enclosure however, is not a visual representation of the images captured by the customer that is received by an image provider and stored on a database as claimed by applicants. The images in Kolling et al. are instead supplied by the service provider not by the owner of the combined image captured telecommunication device. The Examiner acknowledges that Reelee et al. does not provide a periodic statement. Accordingly, it is respectfully submitted that Reelee et al. could not teach or suggest the providing of visual representation of captured images taken during a predetermined time period along with a periodic statement as taught and claimed by applicants.

In rejecting claims under 35 USC § 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *in Re Fine*, 837 10d 1071, 1073, 5 USPQ 2d 1596. In so doing, the Examiner is expected to make the factual determinations as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 48 USPQ 457 (1966) and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to rise at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. There is no motivation or suggestion in combining references as suggested by the Examiner. It is almost always possible to piece meal the prior art to come up with applicants' invention. However, there must be a clear teaching and/or suggestion in the prior art to make the suggestion

in the prior art to make the combination suggested. In this regard, the Reelee et al. reference is simply directed to the combining of a digital camera with a cellular communication transmission device. There is no teaching or suggestion of storing the digital captured image by the image provider and thus, could not teach or suggest the providing of the visual representations of the captured images with the periodic statement. Reelee et al. is simply directed to transmitting or receiving digital images over the communication network. See column 5, lines 25-49. Thus, this reference is merely directed to the transmission of digital images from the combined cellular phone and captured device to another location.

With respect to the Kolling et al. invention, this reference is simply directed to providing electronic statements for a credit card company. There is no teaching or suggestion of storing digital images that have been captured. This reference is directed to a totally different field from that of the Kolling et al. reference. As set forth in the Field of the Invention in the Kolling et al. reference, Kolling et al. is directed to an electronic statement presentation system, in particular, a system that allows the ability to direct a statement or invoice electronically to a customer. Kolling et al. is not directed to capturing or storing digital images on behalf of customers. It is directed to electronic billing of customers. There is no teaching or suggestion in either of the cited references to combine one with the other, nor would there be any motivation to do so. The motivation as presented by the Examiner is based on hind-sight and not by any teaching or suggestion in the references. There is no logical basis why one in the telecommunication business would look to an electronic billing as suggested by the Examiner. Further, it is respectfully submitted that neither of the cited references could teach the suggestion as taught and claimed by applicants. Both of the cited references still fail to teach or suggest the providing of a bill for communication services that includes visual representation of images that have been captured over a predetermined time period. In addition, either of the cited references teach or suggest sending a bill for communication services that includes visual representation of images for ordering of goods and/or services with respect to those images.



***Group II - Claims 3 and 7***

- B. Rejection of claims 3 and 7 as being unpatentable over Reelee et al. in view of Kolling et al. under 35 USC § 103(a) for the reasons set forth in the Official Action dated December 18, 2002 whereby the Examiner stated that claims 3 and 7 were unpatentable for the reasons set forth therein.

Claims 3 and 7 are dependent claims depending upon independent claim 1 and further set forth the ordering of photofinishing goods and/or services with respect to images and said visual representation provided on the billing statement and also provides that the orders may be placed via the Internet. The Examiner rejected claims 3 and 7 as being unpatentable over Reelee et al. in view of Kolling et al. and further in view of Enomoto et al. The Examiner cited Enomoto et al. for the teaching of ordering photofinishing goods and/or services that are included in a visual representation. The Examiner comes to the conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine the teachings of Kollings et al. and Enomoto et al. to the invention of Reelee et al. The Examiner states that the combination of disclosure taken as a whole suggests the users benefit by time saves by conducting all transaction at the time save. Applicants respectfully submits that the Examiner is using hind-sight as a means for combining the teachings to arrive at applicants' invention. The Enomoto et al. reference is simply directed to an online photofinishing ordering process. There is no teaching or suggestion that this should be combined with either of the Reelee et al. and/or Kolling et al. references. As previously noted, the Reelee et al. reference is just simply directed to a camera having an attachment for use with a mobile imaging phone and the Kolling et al. reference is just simply directed to an electronic billing system. All three are directed to totally different businesses. There is no indication in any of the individual references that one could or should be combined with the other. Here again, it is almost always possible to pick and choose elements in the prior art to arrive at applicants' invention. The three cited references are directed to three totally different and distinct businesses. The Reelee et al. reference is directed to being able to send images to a location by attaching a cellular phone to a camera, the Kolling et al.

reference being directed to an electronic billing statement and the Enomoto et al. reference being directed to a method and system for ordering prints over a communication network. Accordingly, applicants respectfully submits that the invention of these claims are not taught or suggested by the prior art.

***Group III - Claims 4-6***

- C. Rejection of claims 4-6 under 35 USC § 103(a) as being unpatentable over Reelee et al. in view of Kolling et al. and Enomoto et al. and further in view of Loeb et al. for the reasons set forth in the Official Action dated December 18, 2002.

Claims 4 and 6 are dependent upon dependent claim 3 and include the additional step of ordering photofinishing goods and/or services either by a paper form as set forth in claim 4 and 5 or by placing an order by telephone. The Examiner cites Loeb et al. for using a paper order form and telephone. However, the Examiner has taken official notice of the step of returning an order form with payment is old and well known in the art. Applicants respectfully submits that it may be well known and old to place orders using the phone and/or paper. It is not old or known that this should be combined in such a manner whereby the order is for ordering of image goods and/or services and payment of telecommunication services. There is no teaching or suggestion the combining of the four cited references to arrive at applicants invention. Here again, the Examiner is using piece meal hind-sight construction in order to arrive at applicants invention.

***Group IV - Claims 15 and 16***

- D. Rejection of claims 15 and 16 under 35 USC § 103(a) over Kolling et al. in view of Loeb et al. for the reasons set forth in the Official Action dated December 18, 2002.

The Examiner has rejected claims 15 and 16 under 35 USC § 103(a) as being unpatentable over Kolling et al. in view of Loeb et al. Independent claim 15 is directed to a multi-sectional statement for use by a service provider that provides telecommunication image services. The statement includes three portions. A first portion that comprises a bill for invoicing of the telecommunication services and image service charges accumulated for a predetermined period of time, a second portion includes a hard copy index print that contains an image taken during the predetermined time period, and a third section that comprises an order form for ordering photographic goods and/or services based on the images contained in the image print.

Claim 16 is dependent upon claim 15 and includes the limitation that all three portions of the form are separated from one another by perforations allowing them to be easily separated.

The Loeb et al. reference is directed to a system for providing an open ended subscription to commodity items normally available on a term basis which includes a central agent and serves as a front end for commodity suppliers. Loeb et al. is not directed to storing images on behalf of a customer nor is it directed to a billing invoice for a telecommunication and image services for a predetermined period of time. Nor is there any teaching or suggestion for providing an order form for obtaining photographic goods and/or services. As previously discussed, the Kolling et al. reference is directed to an electronic billing system. It does not teach or suggest the providing of a combined telecommunication and image service provider nor does it teach the providing of statement with the three portions as claimed by applicant. Thus, it is respectfully submitted that it could not teach the claimed invention as there are essential elements missing from the combined cited references.

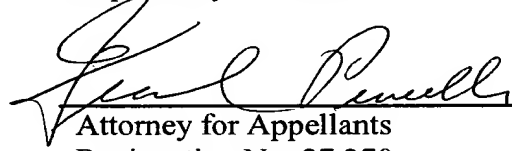
### **Summary**

In summary applicants respectfully submits that the present invention is patentable over the cited art.

### **Conclusion**

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-16.

Respectfully submitted,

  
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## **Appendix I - Claims on Appeal**

1.(Original) A method of managing digital images captured by a customer using a combined portable telecommunications and digital image capture device, said method comprising:

a telecommunication service provider providing a telecommunication service to a customer, said telecommunications service provider forwarding a periodic statement for telecommunication services provided to said customer for a predetermined time period;

providing a data base for receiving and storing said digital images from said customer using said combined telecommunications device to transmit said digital images to said service provider; and

said telecommunication service provider providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement.

2.(Original) A method according to claim 1 comprising the further step of editing of said digital images prior to transmitting said images to said service provider.

3.(Original) A method according to claim 1 comprising the further step of ordering photofinishing goods and/or services with respect to said images included in said visual representation.

4.(Original) A method according to claim 3 wherein the step of ordering photofinishing goods and/or services further comprises completing and returning a paper order form.

5.(Original) A method according to claim 4 wherein the step of ordering photofinishing goods and/or and payment for said telecommunications are returned together toe said telecommunication service provider.

6.(Previously Presented) A method according to claim 3 wherein the step of ordering photofinishing goods and/or services further comprises placing an order by telephone.

7.(Previously Presented) A method according to claim 3 wherein the step of ordering photofinishing goods and/or services further comprises placing an on-line order via the internet.

8.(Original) A method according to claim 1 comprising the further step of:

providing by said telecommunications service provider one combined periodic billing to said customer for the use of said combined portable telecommunication and image capture device, and for the use of said telecommunication services, and for storage and management of said captured images.

9.(Original) A system for managing digital images of a customer, said system comprising:

a telecommunication service provider for providing a telecommunication service to a customer, said telecommunication service provider forwarding a periodic statement for telecommunication services provided to said customer for a predetermined time period;

a combined portable telecommunications and digital image capture device capable of capturing digital images and also for transmitting said captured images to said telecommunications service provider;

a data base for receiving and storing said captured images transmitted from said customer; and

a computer used by said service provider for managing and associating said telecommunications and image storage services for said customer and for providing a visual representation of said captured images captured during said predetermined time period along with said periodic statement.

10.(Original) A system according to claim 9 wherein said visual representation is an electronic display.

11.(Original) A system according to claim 9 wherein said visual representation is a hard copy print.

12.(Original) A system according to claim 9 wherein said telecommunication services comprises telephone services.

13.(Original) A system according to claim 9 wherein said portable combined telecommunication and image capture device comprises a combined cellular phone and a digital camera.

14.(Original) A system according to claim 9 wherein said portable combined telecommunication and image capture device includes a selection device for editing of said digital images prior to transmitting said images to said data base.

15.(Original) A multi-section statement form for use by a combined telecommunications and imaging services service provider, comprising:

a first portion of said form comprising a billing invoice for telecommunications and imaging services charges accumulated for a predetermined time period;

a second portion of said form comprising a hard copy index print containing images taken during a predetermined time period;

a third portion of said form comprising an order form for ordering photographic goods and/or services based upon said images contained in said index print.

16.(Original) A multi-section statement form according to claim 15 wherein all three said portions of said form are separated one from the other by perforations allowing them to be easily separable from each other.